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| EXAMINER | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,470

Applicant(s)

ENDLER ET AL.

Examiner

FOLASHADE ANDERSON

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/07/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 and 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 23 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 04/11/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is the first non-final office action in response to Applicant's telephonic election on June 19, 2008 to the submission filed on April 7, 2004. Currently, claims 1-17, 23 and 29 are pending. Claims 18-22 and 24-28 are withdrawn.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species (I) selecting a meeting location based on the location and mode of transportation, see pg. 6, lines 4-6 and (II) selecting a meeting location based on current location and projected location, see pg. 6, lines 6-8. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, selecting a meeting location from the location of each of the plurality of participants, see pg. 6, lines 1-4 (claim 1) is generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would

not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

2. During a telephone conversation with Frederick J. Zustak (36728) on June 19, 2008 a provisional election was made without traverse to prosecute the invention of species I, claims 1-17, 23 and 29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-22 and 24-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method and System for Selection of a Meeting Location based on Parameters and Mapping Locations.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-16 and 23 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-16 and 23 are non-statutory since they may be preformed within the human mind.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 17 is rejected as being a single means type claim which dose not limit the breadth of the claimed invention this claim covers every conceivable structure (means) for achieving the stated property while the specification discloses at most only those known to the inventor, see MPEP 2164.08 (a).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims a **"typical location"** which is relatively unspecific and broad term.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Applicant claims a "**general geographic area**" which is relatively unspecific and broad term.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 9-17 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 10/324,984).

Claim 1 Wilson teaches a **method comprising:**

- **detecting a plurality of participants** (0039 system obtain a request from a first mobile device for a meeting with a person associated with a second mobile device);
- **detecting a location of each of the plurality of participants** (0039, the system automatically determines locations of the first and second mobile device);
- **selecting a meeting location from the plurality of possible meeting locations based on the location of each of the plurality of participants** (0039, automatically provides information to at least the first or second mobile device regarding a meeting location based at least in

part on the determined location of the first or second mobile device, also see 0098).

Wilson does not expressly teach **identifying a plurality of possible meeting locations based on a parameter**. Wilson does teach allowing the user to identify a point of interest (POI) category type (0092). The POIs returned to the use are based on the user's own criteria (0093).

The simple substitution of a known element, point of interest category type, in place of another to produce a predictable result, identifying a plurality of possible meeting locations, would have been within the expertise of one of ordinary skill in the art at the time the invention was made thus rendering the claim obvious.

Claim 9 Wilson teaches **location of one of participants is a current location detected through a device detection module** (0049, the GMLC includes a phone locator subsystem that work with the GMLC such as the e-Mobility Location Center provided by Nortel).

Claim 10 Wilson teaches **the location of one of participants is a projected location based on a typical location of the participant for a time and date of a possible meeting** (0039).

Claims 11 and 12 which are directed toward a specific type of meeting location, parameter i.e. **food service, beverage service**. Official notice is taken that **food service, beverage service** were old and well known location types at the time the invention was made as evidenced by Wilson (0092, categories may include for example, restaurants, bars).

Further the Examiner holds that specifying a specific type of parameter is nonfunctional material and is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106

Claims 13 and 14 are similar in scope to claims 11 and 12 in that they are direct toward nonfunctional material as such are reject for the same reasoning given in regards to claims 11 and 12.

Claim 15 Wilson teaches **a general geographic area** (0092 user selects a neighborhood/city/sites and provides this information to the portal).

Wilson does not teach that the location is a **"parameter"**; however it is implied in the context of the reference that the area selection of Wilson acts as a constraint or parameter to limit the meeting location. Therefore the **"parameter"** is obviously implied in the prior art.

Claim 16 Wilson teaches **the meeting location is geographically located between the location of each of the participants** (0098, coordinate a meeting equidistant between these friends and the user. The system via the location engine computes a midpoint between the user and friends and performs the functions above to permit the user to identify a desired POI at this midpoint or "geographic center").

Claim 17 and 29 which are directed toward the system and medium respectively for implementing the method of claim 1 is substantially similar to claim 1 and is therefore rejected for the same reasoning given above with regards to claim 1.

12. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) as applied to claim 1 and in further view of Perrella et al (US Patent 7,139,722).

Claim 2 Wilson is silent on **determining a mode of transportation for each of the plurality of participants.**

Perrella teaches **determining a mode of transportation for each of the plurality of participants** (col. 5, lines 21-26) in an analogous art for the purpose of calculating estimated arrive times to a meeting.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Perrella in the invention of Wilson to allow notification of the user's timeliness to other meeting participants (Perrella col. 1, lines 46-49).

Claim 3-5 which are direct to a specific mode of transportation i.e. **car, bus, foot** Wilson is silent on these features. However official notice is taken that **car, bus, foot** were old and well known know modes of transportation at the time the invention was made as evidenced by Perrella (col. 5 lines 22-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the any old and well know mode of transportation in the invention of Wilson to allow notification of the user's timeliness to other meeting participants (Perrella col. 1, lines 46-49).

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) and Perrella et al (US Patent 7,139,722) as applied to claim 2 and in further view of Hall (US Patent 6,937,853 B2).

Claim 6 Wilson is silent on **selecting the meeting location is based on the mode of transportation for each of the plurality of participants**. However Wilson does teach meeting location based on user criteria (0093).

Perrella is silent on **selecting the meeting location is based on the mode of transportation for each of the plurality of participants**. However Perrella takes into the mode of transportation when predicting a user's meeting arrival time (col. 5, lines 20-24)

Hall teaches **selecting the meeting location is based on the mode of transportation for each of the plurality of participants** (col. 1, lines 55-65, where a fleet of vehicles is equivalent to the mode of transportation) in an analogous art for dynamically updating data.

It would have been obvious to one of ordinary in the art at the time the invention was made to include the teachings of Hall in the invention of Wilson to allow for accurate accounting for a common acceptable meeting time among meeting participations

14. Claim 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) and Perrella et al (US Patent 7,139,722) as applied to claim 2 and in further view of Jones et al (US Patent 7,181,410 B1).

Claim 7 Wilson and Perrella are silent on **determining the mode of transportation for each of the plurality of participants is based on a time and day of a possible meeting.**

Jones teaches **determining the mode of transportation for each of the plurality of participants is based on a time and day of a possible meeting** (abstract) for the purpose of goal oriented travel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the user's arrive at the meeting on time (col. 1, lines 42-44).

Claim 8 Wilson and Perrella are silent on **determining the mode of transportation for each of the plurality of participants is based on a speed of movement of each of the plurality of participants.**

Jones teaches **determining the mode of transportation for each of the plurality of participants is based on a speed of movement of each of the plurality of participants** (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the user's arrive at the meeting on time (col. 1, lines 42-44).

Claim 23 is substantially similar in scope to claims 1, 2, 8 and 10 and is therefore rejected for the same reasoning given above with regards to these claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kaufman et al (US Patent 7,027,995 B2) teaches a system too optimize meeting location given the participants clusters and their proximity to the available meeting location. Adamezyk et al (US Patent 7,328,029 B1) teaches tracking of meeting participants. Rosenberg (US Publication 2006/0227047 A1) teaches a meeting location based on the estimated travel speed of each meeting participant. Petel (US Publication 2005/0119927 A1) teach predicting arrive times of meeting participants. Chen et al (US Publication 2007/0118415 A1) teaches an intelligent meeting scheduler.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Beth Van Doren/
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